

REMARKS/ARGUMENTS

Claims 1-19 are pending in the present application. Claims 1, 4, 5, and 9 are amended. Claims 12-19 are new. Claims 1, 5, and 9 are independent claims.

In view of the amendments and the following remarks, the Examiner is respectfully requested to reconsider the outstanding rejections.

Amendment to Claim 9

In the Amendment After Final filed December 1, 2003, and entered pursuant to the RCE filed on February 10, 2004, independent claim 9 was amended. In the present Amendment, claim 9 has been amended to withdraw the Amendment made on December 1, 2003, and return claim 9 to its original form (as filed in the Amendment of June 9, 2003).

Accordingly, Applicant respectfully submits that claim 9, as amended above, is no longer subject to any estoppel that might have been created by the Amendment of December 1, 2003. Instead, Applicant respectfully submits that claim 9 is now entitled to its full range of equivalents.

Similarly, claim 5 has been amended above to withdraw part of the amendments made by the After Final Amendment filed December 1, 2003. Accordingly, Applicant respectfully submits

that the present amendment to claim 5 effectively removes any estoppel created by the portion of the amendments of December 1, 2003, which has been withdrawn by the amendment above.

Drawing Objections

In the outstanding Office Action, the Examiner objected to Fig. 2 because the reference number "260" was missing from one of the transmitters TX_n in element 112. Applicant respectfully submits that in the attached drawing correction to Fig. 2, the reference number "260" has been added as indicated by the Examiner. Thus, the Examiner is respectfully requested to withdraw the drawing objection.

The Examiner further objected to the drawings for failing to include reference numbers mentioned in the description. Specifically, the Examiner indicated that the figures do not include reference numbers "220" and "230," which are mentioned on page 10, lines 15-16 of the present specification. Applicant respectfully submits that the inclusion of reference numbers "220" and "230" in the specification was the result of typographical errors. Applicant further submits that the specification has been amended to replace these reference numbers with "120" and "130," respectively, in order to correct the typographical errors. Since the figures include reference

numbers "120" and "130," it is respectfully requested that the Examiner withdraw this objection.

Claim Objections

The Examiner objected to claim 1 and 4 because of minor informalities. Applicant respectfully submits that claims 1 and 4 have been amended based on the Examiner's suggestions. Accordingly, withdrawal of these objections is respectfully requested.

Rejection Under 35 U.S.C. § 103

Claims 1 and 2 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 4,449,247 to Waschka, Jr. (hereinafter Waschka). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

As amended, independent claim 1 now recites cascading more than two optical communication channels for bit error rate testing. Applicant respectfully submits that Waschka fails to teach or suggest this feature.

In Waschka, a bit error rate (BER) test unit 22 is used to selectively conduct a bit error rate test of a particular one of five normally active optical fiber channels or an auxiliary

channel. As shown in Fig. 1 of Waschka, the channel being tested connects terminal station 10 to terminal station 12, and includes a west-to-east link and east-to-west link. Waschka discloses that the BER test unit 22 sends a test sequence over the west-to-east link, and that the test sequence is looped at station 12 to be transmitted back over the east-to-west link. See column 19: lines 25-29 of Waschka.

It is apparent that the Examiner relies upon the loop-back connection between the west-to-east link and east-to-west link as disclosing the cascading of two channels, even though Waschka discloses that this configuration is used for testing a single fiber optic channel. Assuming for the sake of argument that the Examiner's interpretation is proper, Applicant respectfully submits that this interpretation at most suggests cascading two optical communication channels. Thus, Applicant respectfully submits that there is no teaching or suggestion in Waschka, even using the Examiner's broad interpretation, of cascading more than two optical communication channels in order to conduct bit error rate testing, as required by independent claim 1.

Applicant respectfully submits that claim 1 is allowable over Waschka at least for the reasons set forth above. Further, Applicant submits that claim 2 is allowable over Waschka at least

by virtue of its dependency on claim 1. Thus, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Claims 1 and 2 also stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,229,631 to Sato et al. (hereinafter Sato) in view of Waschka. This rejection is respectfully traversed.

Applicant respectfully submits that Sato fails to remedy the deficiencies of Waschka as set forth above in connection with independent claim 1. In other words, Applicant submits that Sato fails to disclose cascading more than two optical communication channels.

In this rejection, the Examiner relies upon Fig. 12 of Sato to show a cascaded configuration of multiple optical communication channels. However, Applicant respectfully submit that at most, Fig. 12 in Sato discloses a configuration whereby transmitter/receiver 110 is connected to repeater 120 via transmission lines 100a and 100b of optic fibers. Similar to Waschka, Fig. 12 of Sato illustrates a loop-back configuration in which signals sent by the transmitter/receiver over line 100a can be looped back at the repeater so that the signals can be sent back to the transmitter/receiver via line 100b. Thus, even if lines 100a and 100b can be interpreted as different optical

communication channels, Fig. 12 at most illustrates only two channels being cascaded.

Accordingly, Applicant submits that Sato fails to provide a teaching or suggestion of cascading more than two optical communication channels to perform bit error rate testing, as required by independent claim 1. For reasons discussed above, Applicant submits that Waschka also fails to teach or suggest such a feature.

For the reasons set forth above, Applicant respectfully submits that claim 1 is allowable over Sato and Waschka, either taken alone or in combination with one another. Applicant further submits that claim 2 is allowable at least by virtue of its dependency on claim 1. Thus, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 3 - 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Waschka in view of U.S. Patent No. 6,351,322 to Ransford et al. (hereinafter Ransford). Claims 3-11 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Waschka, and further in view of Ransford. These rejections are respectfully traversed.

Specifically, Applicant respectfully submits that Ransford does not qualify as prior art under 35 U.S.C. § 103. As amended on November 29, 1999, Section 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the s subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Thus, if an application was filed November 29, 1999, subject matter qualifying as prior art under 35 U.S.C. § 102(e) is disqualified as prior art under § 103 if that subject matter was commonly assigned to the same entity as the application. See MPEP § 706(1)(1).

The present application was filed on April 17, 2000. Since Ransford was issued after this date, Ransford only qualifies as prior art under § 102(e). Furthermore, at the time the invention was made, the present application and Ransford were commonly owned and assigned to CIENA Corporation.

Accordingly, Applicant respectfully submits that Ransford is disqualified as prior art under § 103. Thus, Applicant submits that the § 103 rejections utilizing Ransford are not proper, and that claims 3-11 are now in condition for allowance. Therefore, the Examiner is respectfully requested to reconsider and withdraw these rejections.

New Claims

Applicant respectfully submits that new claims 12-19 are allowable at least by virtue of their dependency on allowable claims. Specifically, each of claims 12-19 are dependent upon one of the independent claims (claims 1, 5, and 9), which are allowable at least for the reasons discussed above. Accordingly, Applicant respectfully submits that claims 12-19 are now in condition for allowance.

Conclusion

In view of the above amendments remarks, the Examiner is respectfully requested to reconsider the outstanding claim rejections and issue a Notice of Allowance in connection with the pending claims.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is strongly encouraged to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned in order to conduct an interview in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any

additional fees required under 37 C.F.R. §§ 1.16 or 1.17;
particularly, extension of time fees.

Respectfully submitted,

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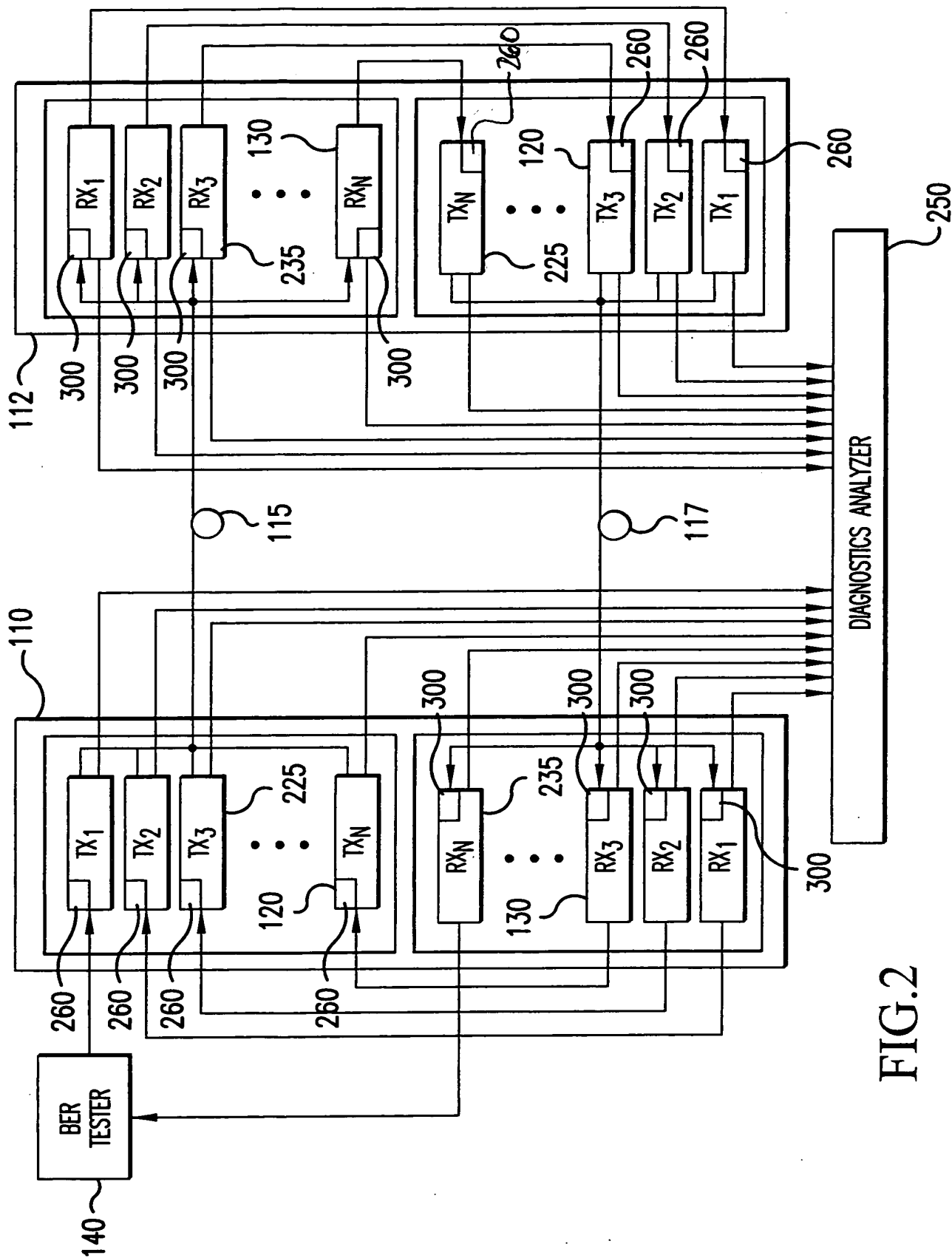


FIG.2